The Intellectual Properties Committee met November 16, 2005. The following members present: Dr. Jim Blair, Dr. Tim Pickering, Dr. Joe Falkingham, Ms. Carol Roberson, Dr. Tom Caruso, Dr. Tom Sherman, Mr. Mark Sumner, Dr. Craig Nessler, Mr. Ken Miller. Ms. Debbi Lucas attended as a guest and Ms. Debbie Nester recorded the minutes.

Call to Order

Dr. Blair called the IP Committee meeting to order at 12:05 p.m. Dr. Blair mentioned that it was not a real heavy agenda he would like to add one thing to it an update on policy 13000. He will report back to the Commission on Research on that. It was added to the bottom of the agenda.

Approval of Minutes

Dr. Blair called for a motion to approve the minutes of August 17, 2005. Dr. Nessler made the motion to accept the minutes, seconded by Dr. Pickering and the motion was unanimously passed.

Update on Conflicts

Dr. Blair reported that he wanted to give an update on one issue that we had from the last meeting. We had complaints from students that were named as co-inventors on a disclosure that ended up not going in as co-inventors on actual patent filing. It was from a course they taught and used the course to further develop some intellectual property and put all of the student’s names on these and when it went to a lawyer with written a description of what each student had contributed. The lawyer interpretation was that not all students contributed as inventors by the legal definition and that only those meeting that standard were included in the full patent applications. However, we have had contacts from at least three of the students that don’t like being left off or don’t like the royalty sharing suggested. Dr. Blair met with the patent attorney, Mr. Mike Whitham, to confirm a plan. Mr. Whitham provided sheet that describes inventorship. Dr. Blair will send out a letter to everyone involved including all students. The letter would explain what was done and the process by which the inventors were identified and a copy of this description of the inventors and contributions to the inventors. If they still have any objection to the assignment then they should notify us on these bases. Mr. Whitham says that if they still challenge this we can make a ruling but the ruling has no legal standing. The students would have to go out and get their own lawyers and sue in court for...
some kind of action out of this. If there is something we certainly need to have documented that this group has looked at that. Then we may have to make some decisions to royalty sharing. It is moving slowly we are not really ready to come back to the committee.

We had another issue that we thought was going to come to this committee which may be resolved by the inventors involved and assistance of the patent attorney. Two patent applications were submitted by VTIP with overlapping claims but different inventors. After discussion with the attorney, all involved agreed that the first attempt should be to clarify the claims on each of the applications to the patent office and clearly show the distinction of the two applications. Mr. Whitham felt this approach should work but will come back to the inventors if another solution is needed. Currently, no action by the IP Committee will be needed.

**VTIP Director**

We are in the final stages of negotiating to get someone here as the VTIP director.

**Copyrights**

Dr. Blair reported that he is getting a lot of questions whether to disclose copyright materials. Much of this falls into the gray area of software/computer code which might be best released under open source criteria. In general, faculty have been advised to disclose things which were supported by university resources or which they felt needed protection as a Virginia Tech copyright. In most cases, those copyrights disclosed assigning ownership to the university will be accepted on behalf of the university by the IPC (by the same standards as invention disclosures). If questions arise concerning ownership or whether a disclosure represents a traditional form of scholarship, the IPC will assist with that determination and will require a disclosure. Ms. Roberson raised the question whether we should be turning copyrights accepted for the university over to VTIP? Dr. Blair was not sure. Ms. Roberson said that the issue that VTIP faced recently was that a disclosed copyright was assigned to VTIP. However, when it was reviewed by VTIP with the faculty members they wanted to keep it as open source. There was no commercial value and VTIP agreed to let them do it as open source. But the authors also wanted to be able to disseminate the material and credit it to Virginia Tech and their department. Dr. Blair read from Policy 13000 section D: All IPs assigned to the university shall flow to VTIP by assignment for operational management. However, he noted that the university does retain the right to use for research or educational purposes any IP turned over to VTIP. The committee agreed that copyright material accepted by the IPC on behalf of Virginia Tech should be transferred to VTIP and that authors of those materials will have rights to use that material for research and educational purposes.
Discussion of the new disclosure form

Dr. Blair informed the committee that we need to move ahead and get the new disclosure form implemented. He reminded them that they were sent another version. We have received several editorial comments. Ms. Roberson reported that she sent the form out to two patent attorneys. One patent attorney responded that this is one of the better ones he has seen. Ms. Roberson mentioned a list of changes that she received. Ms. Roberson has asked a patent attorney if the record of invention page needs to be added to our form? She has not received an answer. Dr. Blair recommended to incorporate it only if the patent attorney tells us that it really is necessary. Ms. Roberson mentioned that no other universities have that. Dr. Nessler made the motion to approve and allow minor corrections, seconded by Dr. Falkinham and the motion was unanimously passed.

New Items

Dr. Blair presented our progress on Policy 13000 as well as the Practices document that we are starting to generate. He thinks that the next step is that we go out on the road in public forums across the university to present where we are. The policy needs to go through the board of visitors which will probably be a non-controversial issue. Before we do that, the changes and interpretation should be made public and feed back from faculty entertained.

Dr. Blair mentioned one issue that came up and not sure if it was from the Virginia Tech Foundation or internal that wanted Kevin Sullivan added as ex officio. The old policy said the director of business affairs and controller for Virginia Tech Foundation. We took care of it and we just identified the university controller. The president’s office said to add Kevin Sullivan to the list. Mr. Sullivan is the legal counsel for VT Foundation not the university. Dr. Blair asked if there was any reason that someone from VT Foundation should be on this board. Dr. Blair reported that there is no sense of the committee that we really think it’s important that that position be added – they can be invited if they want to come. Dr. Blair will go back through Kevin Sullivan and then maybe have him go to the President or to Ms. Kim O’Rourke. Dr. Blair reported that the board will have to approve the changes. We will keep the way it is. Dr. Blair will pursue the matter with Kevin Sullivan and whether they just are invited we’ll put them on the mailing list and invite them to join. Dr. Blair said we’d be adding another voting member if we put it on in that fashion and I don’t think that was the intent.

Dr. Blair said we need to set up a schedule and list of groups – who do you think we should do presentations to? Dr. Blair said we can ask specifically to get on the faculty senate agenda. Dr. Blair said given the issues previously with the engineering faculty group there will be enough interest there that we would set it up. Dr. Falkinham said going to engineering faculty because they have shown an interest before and secondly, going to faculty senate and leave it at that until the individuals who are there on faculty senate if they think their department or whatever administrative unit they are representing would be interested then we could do
something individually maybe members of the committee. Dr. Blair said but we still have a responsibility to make generally known. Dr. Falkinham suggested putting it on the web page. Dr. Blair said he was thinking more of a newsletter article – here’s the general sense. Go to the web page to read the draft document on that. Dr. Blair said that he wants them to be aware of the changes in policy and maybe some discussion on the things we would like to see happen. Dr. Blair said he would probably ask somebody out of the faculty side to go and stand up – maybe not have to do any presentation – at least say this was not an administrative decision and that it really did come to the committee. There is no change in policy.

**Adjournment**

Dr. Blair announced the meeting adjourned at 1:07 p.m.